



Paper No. 19

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OFFICE OF PETITIONS

In re Application of	:	
Heinrich, et al.	:	
Application No.: 09/382,382	:	DECISION REFUSING STATUS
Filed: August 24, 1999	:	UNDER 37 CFR 1.47(a)
Attorney Docket No.: YO995-218	:	
For: RADIO FREQUENCY IDENTIFICATION	:	
SYSTEM WRITE BROADCAST CAPABILITY	:	

This is a decision on the petition under 37 CFR 1.47(a), filed September 28, 2003.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

On July 1, 2003, a Notice of Allowance was mailed that required petitioners to submit an executed declaration within three months of the mail date of the Notice. The instant petition was filed on September 28, 2003.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Applicants have failed to establish that the non-signing inventor, Christian Lenz Cesar cannot be located. The petition contains a declaration by Attorney John H. Sherman who states that an Express Mail package containing a copy of the application and a declaration was mailed to Dr. Cesar at his last known address on September 20, 2003, and that the package was not deliverable. Exhibit E to the Sherman declaration is an e-mail dated September 24, 2003 from Carlene Pierson to Attorney Sherman. Ms. Pierson writes that an unidentified woman answered the telephone at Dr. Cesar's last known telephone number and stated that Dr. Cesar is in Europe for three weeks.

A showing of **diligence** is critical in obtaining Rule 47 status when an inventor cannot be located

or reached. While petitioners' mailing to Dr. Cesar was not delivered, there is evidence to show that he would not be adverse to receiving mail concerning this application. Dr. Cesar, himself, provided petitioners with his correct mailing and e-mail addresses. Furthermore, the evidence presented shows that Dr. Cesar's lack of cooperation is a function of his being out of the country. A woman answering the telephone at his last known phone number stated that he was out of town for three weeks. As stated in MPEP 409.03(d), "The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47(a)."

Petitioners must engage in further efforts to obtain a signed declaration from Dr. Cesar. Petitioners have a two month extendable period to reply to this decision. Dr. Cesar's trip to Europe will be over long before any reconsideration petition is due.

The Office requires petitioners to mail a complete copy of the application, including specification, claims and drawings, and the declaration to the inventor's last known address with the request that he sign the declaration.

It appears that petitioners have located Dr. Cesar's residence. Thus, inability to reach/locate him is not a ground for granting 47 status. Thus, in order to obtain 47 status, petitioner must show refusal, either express or constructive, on Dr. Cesar's part to execute the declaration. When petitioners can show that Dr. Cesar received the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration, petitioner will have satisfied this requirement.

Any written refusal to sign the declaration should be included as documentary evidence in any reconsideration petition. If there is an oral refusal, the facts surrounding the refusal should be included in a declaration by a party with first hand knowledge of the refusal. If it is concluded by the 37 CFR 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration.

The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Pursuant to petitioners' authorization, deposit account no. 14-1190 will be charged the \$130 fee associated with filing a petition under 37 CFR 1.47(a).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

By Fax: (703) 308-6916
ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (703) 308-6712.


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